

AMENDMENTS TO THE DRAWINGS:

Please find accompanying this response Figures 1 and 2.

REMARKS

Claims 15-29 are now pending in this application. Claims 15-28 are rejected. Claims 1-14 are previously cancelled. New claim 29 is added. Claim 18 was amended to place it in better form. The specification has been amended to place it in better form. No new matter has been added.

The specification has been objected to for various informalities, including not providing support for claims 17 and 18, not including Figures 1 and 2, and not including the Brief Description of the Several Views of the Drawings section. The informalities in the specification have been addressed. The subject matter of original claim 3 has been added to the specification to support claims 17 and 18, as suggested in the Office Action. The Brief Description of the Several Views of the Drawings section has been added to the specification. Figures 1 and 2 are submitted herewith based on Figures 1 and 2 of the PCT application. A verified English translation of Figures 1 and 2 of the PCT application is also submitted herewith.

Claims 15, 26, and 28 have been rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Regarding claim 15, the Office Action states that the specification provides support for "a metal oxide" but not for "at least one metal oxide." However, original claim 1 recites "metal oxides" and this provides support for including more than one metal oxide. Accordingly, there is sufficient support for the

recitation of at least one metal oxide since this is a combination of a metal oxide and more than one metal oxide. The recitation of original claim 1 has been incorporated into the specification by amending the Summary of the Invention section to recite "a metal oxide or metal oxides". Additionally, the disclosure of "mixed phases resulting therefrom" on page 7, second full paragraph of the substitute specification and the recitation of "corresponding mixed phases" in original claim 4 implies that the magnetic nanoparticles can include more than one metal oxide. It is Applicants' position that the disclosure of the specification provides sufficient support for the term "at least one metal oxide". Moreover, Applicants respectfully note that the disclosure as originally filed does not have to provide *in haec verba* support for the claimed subject matter at issue. *See Cordis Corp. v. Medtronic AVE Inc.*, 67 USPQ2d 1876, 1885 (Fed. Cir. 2003).

Regarding claims 15 and 28, the Office Action states that the specification discloses the use of an alkaline medium and/or the use of a solution of ammonia in water when the metal oxides are produced in situ. Although the specification has support for the use of an alkaline medium and/or the use of a solution of ammonia in water when the metal oxides are produced in situ, the disclosure is not so limited. There is no disclosure in the specification that the use of an alkaline medium and/or the use of a solution of ammonia in water is only applicable when the metal oxides are produced in situ. The disclosure on page 8, first full paragraph of the substitute specification to an "alkaline carrier medium" as well as

the disclosure of the use of sodium hydroxide in the examples demonstrate the importance of controlling the pH to be > 7 . Thus, it is Applicants' position that claims 15 and 18 have full support in the specification.

The Office Action states that claim 26 recites a pressure of 500 bar or greater and that the specification recites a range of 500-1200 bar. Original claim 10 recites a pressure of 500 bar or greater. Accordingly, sufficient support exists in the original disclosure for the recitation of 500 bar or greater. The recitation of claim 10 as originally filed has been added to the specification.

Claims 15-28 have been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-44 of copending Application No. 10/888,189 ("copending application"). Since the nonstatutory obviousness-type double patenting rejection is provisional, it will be addressed in due course.

New claim 29 has been added. Support for the new claim is found in, for example, the substitute specification on the first full paragraph of page 8. The specification has been amended to be in better form. Support for the amendments can be found in, for example, the claims as originally filed.

Applicants respectfully request a one month extension of time for responding to the Office Action. **The fee of \$120.00 for the extension is provided for in the charge authorization presented in the PTO Form 2038, Credit Card Payment form, provided herewith.**

If there is any discrepancy between the fee(s) due and the fee payment authorized in the Credit Card Payment Form PTO-2038 or the Form PTO-2038 is missing or fee payment via the Form PTO-2038 cannot be processed, the USPTO is hereby authorized to charge any fee(s) or fee(s) deficiency or credit any excess payment to Deposit Account No. 10-1250.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,
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enc: Figures 1 and 2
Verified English translation of Figures 1 and 2 from the PCT Application
Form PTO-2038



F-8916

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Joachim TELLER, et al.
Serial No. : 10/564,228
Filed : February 8, 2006
For : MAGNETIC NANOPARTICLES HAVING
IMPROVED MAGNETIC PROPERTIES
Group Art Unit : 1645
Examiner : Carol M. Koslow
Confirmation No. : 7421
Customer No. : 000028107

Assistant Commissioner for Patents
Washington, D.C. 20231

VERIFICATION OF TRANSLATION

Sir:

I, Sarah Hubinger, residing at 295 Convent Avenue, New York, New York 10031, hereby declare that I am fluent in German and that the attached Figures 1 and 2 are in English and German and that the English is a true and accurate translation of the German.

I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false

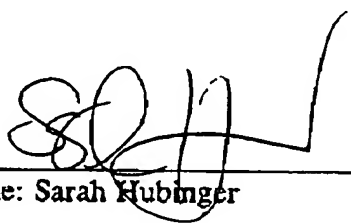
F-8916

Ser. No. 10/564,228

statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: 7/3/08

By


Name: Sarah Hubinger

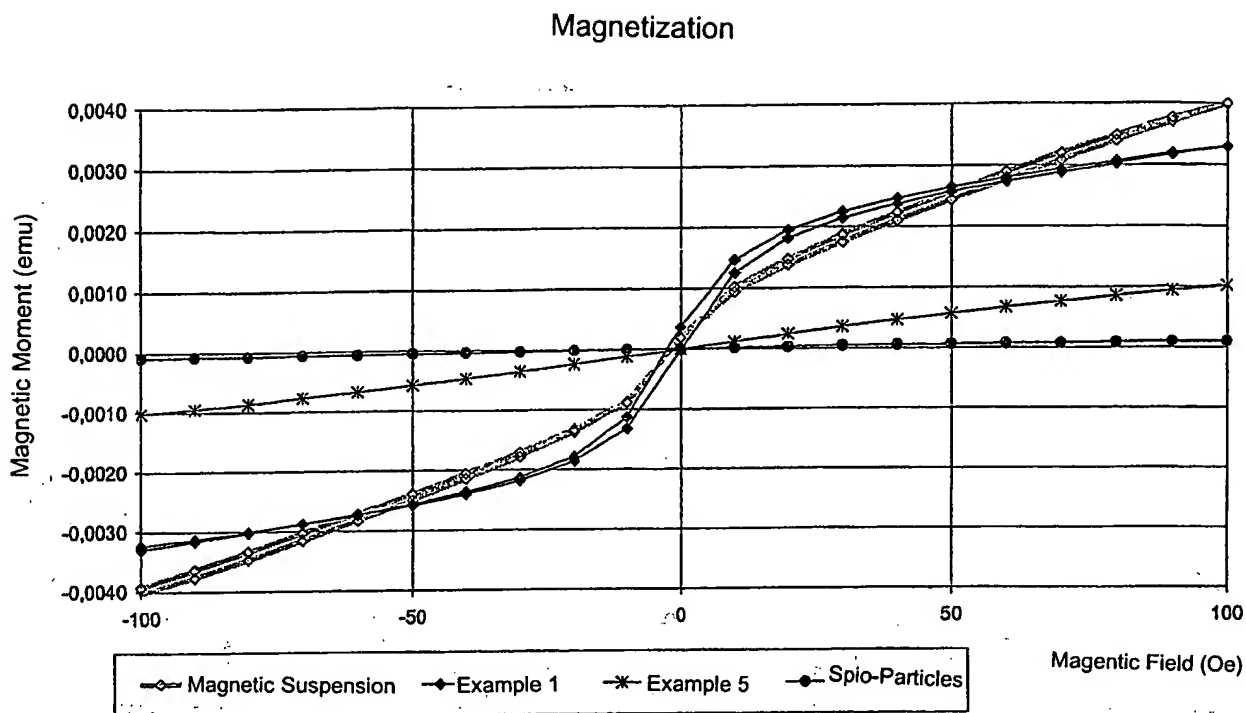


Figure 1. Measuring of magnetization of each 0,3mg particles in 60 μ l suspension

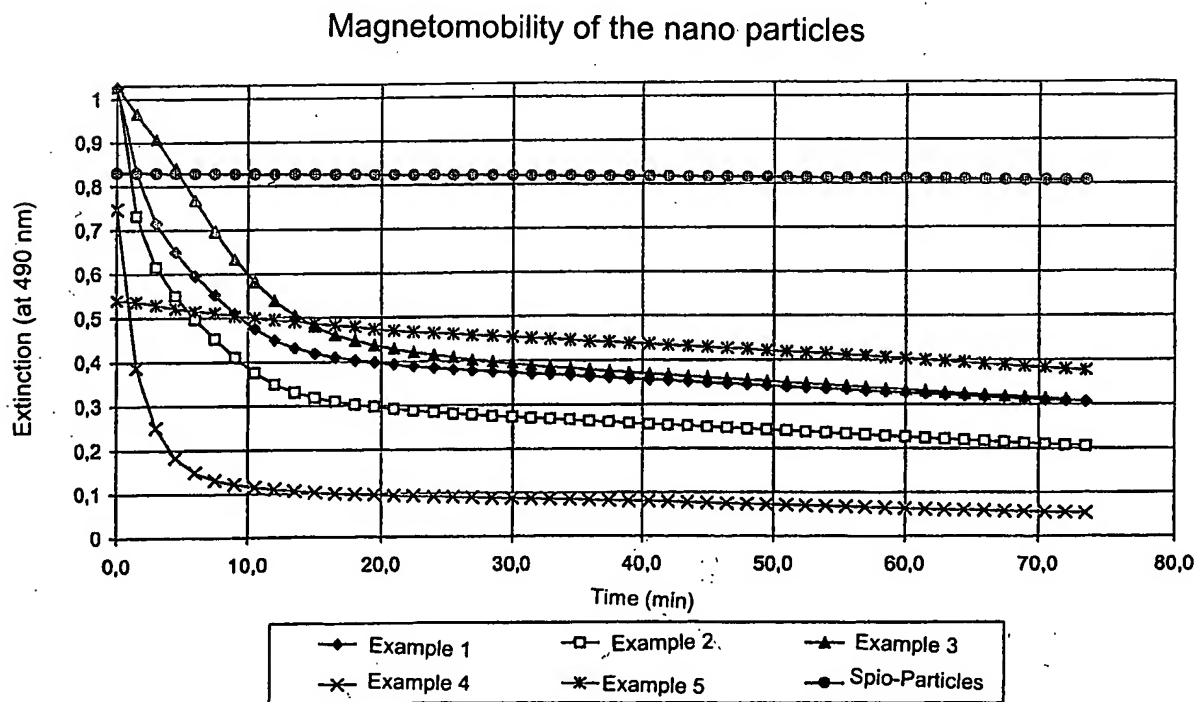


Figure 2. Measuring of the decrease of extinction of the nanoparticle suspensions (Examples 1-5) through separation of the particles on a permanent magnet in connection with time (wave length: 490 nm, iron concentration of particle suspensions: 60-70 μ g/mL).

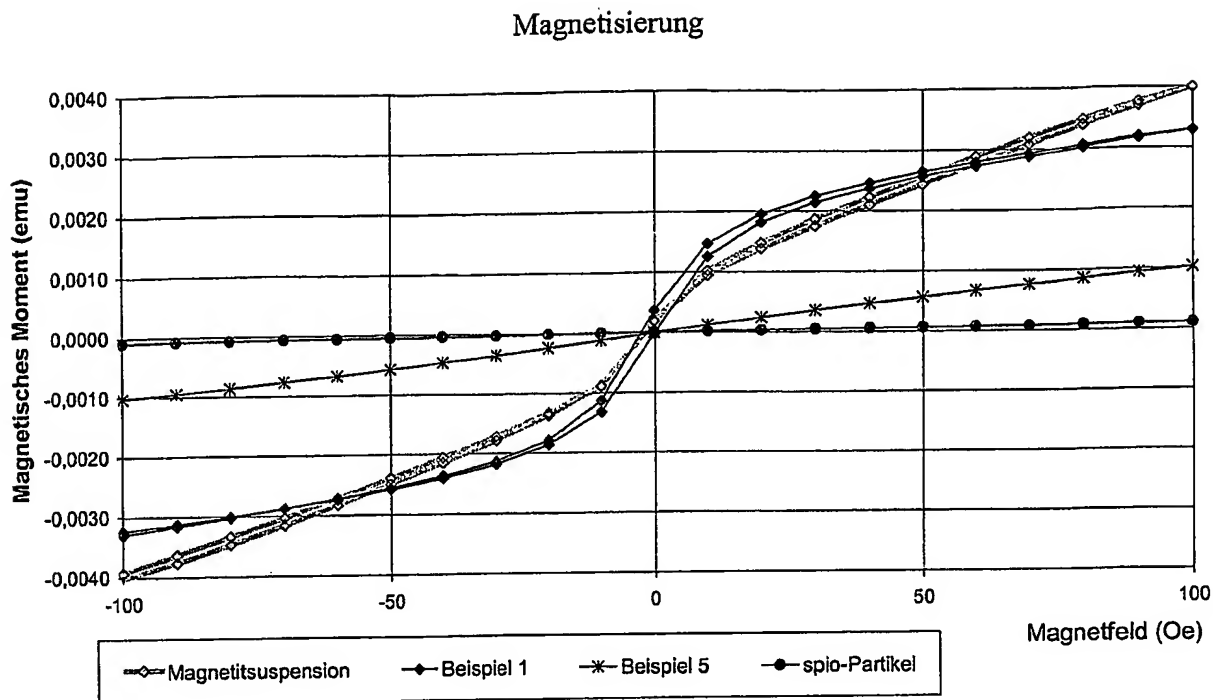


Abbildung 1. Messung der Magnetisierung von je 0,3 mg Partikel in 60 μ l Suspension.

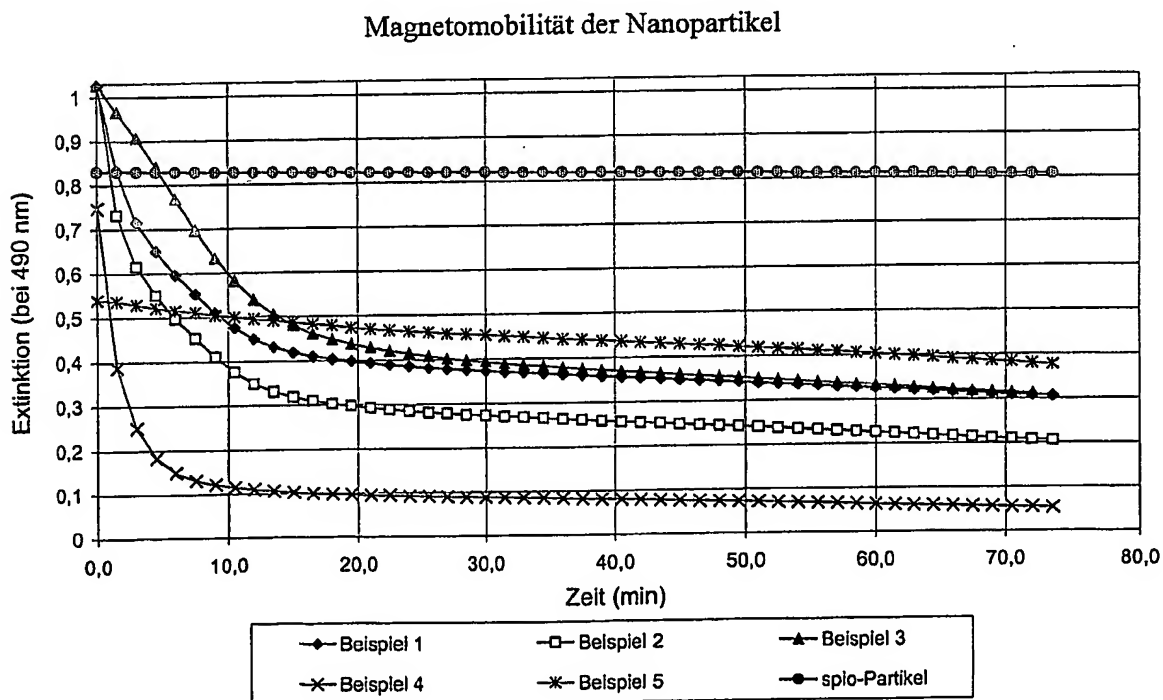


Abbildung 2. Messung der Extinktionsabnahme der Nanopartikelsuspensionen (Beispiele 1 - 5) durch Separation der Partikel an einem Permanentmagneten in Abhängigkeit von der Zeit (Wellenlänge: 490 nm, Eisenkonzentration der Partikelsuspensionen: 60 - 70 μ g/ml).